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P.O. BOX 3001
BRIARCLIFF MANOR, NY 10510

EXAMINER

PHU, SANH D

ART UNIT PAPER NUMBER

2682

DATE MAILED: 05/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/817,086

Applicant(s)

SIMON, JEAN-MICHEL

Examiner

Sanh D Phu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is responsive to the applicant's response filed on 1/24/05.

Specification

2. The Specification and Abstract of amendment, which was filed on 4/1/04, is objected under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

- "an apparatus that avoids the necessity of using a computer for updating operation software within a storage device"; and
- In Abstract "The operation of the apparatus (1) depends on operation software contained in a storage device (45). It often appears to be necessary to update the stored operation software. For this purpose, update data contained in another storage device of another apparatus (50), of the same type as the apparatus (1), is tapped by the apparatus (1) for storage within storage device (45). This updating technique for

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the stored operation software has an application to portable cellular telephony apparatus."

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections – 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 5, 7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 recites the limitations "a storage device for storing operation software" and "updating means for updating the operation software stored within said storage device via an interfacing with another apparatus of the same

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type". These limitations are considered new matter because the specification, as originally filed, does not support for such limitations.

Claim 5 recites the limitations "storing operation software in a first apparatus" and "tapping update data from a second apparatus of the same type as the first apparatus to update the operation software in the first apparatus".

These limitations are considered new matter because the specification, as originally filed, does not support for such limitations.

Claim 7 recites the limitation "means for exchanging update data for updating operation software stored within a first apparatus wherein a second apparatus communicates the update data to the first apparatus and the operation software stored within the first apparatus is updated with the update data". This limitation is considered new matter because the specification, as originally filed, does not support for such limitation.

Claims, (if any) depended on above claims, are therefore, also rejected. The below rejections are assuming that the limitations of the amendment are not new matter.

5. The following rejections are assuming that the limitations of the amendment are not new matter.

Claim Rejections – 35 USC § 102/103

6. Claim 1,2, 5-7 are rejected under 35 U.S.C 102(e) as anticipated by Yasuda et al (5,062,132) (prior art of record) or in the alternative, under 103(a) as obvious over Yasuda et al in view of Ellis et al (6,771,317) (previously cited).

–Regarding to claim 1, (see Fig. 1,2 & 3 and col. 2, line 49 to col. 5 line 38) Yasuda et al disclose an apparatus (1B) wherein the apparatus comprises a storage device (9) for storing data, and updating means (8,11A, 11B, 21) for updating data stored within said storage device from another apparatus (1A) of the same type (see Fig. 3 and col. 3, line 58 to col. 4 line 7).

Yasuda et al further discloses that the data can be data types of different telephone numbers, or other data types that are capable to be stored by the storage device RAM (9) (see col. 2, lines 66-68), and that the first apparatus (1B) is a programmable device (see col. 1, lines 33 and 34 and (8) of figure 1). Yasuda fails expressly disclose the storage device (9) is for storing operating software and the updating means (8,11A, 11B, 21) for updating software,

however, since the first apparatus (1B) ~~is~~ inherently includes operating software, being stored in the storage device RAM(9), to be executed by microcomputer (8) to operate the system, therefore, the updating means inherently include updating the operating software for the first apparatus (1B) so that it is able to function with updated version.

Or, in the alternative, Ellis et al, in an analogous art, disclose that the storage device (RAM or ROM) is for storing operating software and able to be updated with an updating software being received from a remote station (see col. 9, lines 16–21). Therefore, it would have been obvious for a person skilled in the art to modify Yasuda et al in such a way that the data storing in the RAM or ROM is also storing the operating software and the updating means for updating the operating software, as taught by Ellis et al, in order to replace an outdated operating software with an updated software so that the first apparatus is able to function with updated version.

–Regarding to claim 2 (see fig. 2), Yasuda et al disclose that said updating means are formed by a serial wire link (21) (see Fig. 2, col. 3, lines 48–58).

–Regarding to claim 5, (see Fig. 1,2 & 3 and col. 2, line 49 to col. 5 line 38), Yasuda disclose that a method comprises:

storing, by using a storage device (9), data in a first apparatus (1B) (see Fig. 3 and col. 3, line 58 to col. 4 line 7); and

taping, by using updating means (8,11A, 11B, 21), update data from a second apparatus (1A) of the same type as the first apparatus to update the data in the first apparatus (see Fig. 3 and col. 3, line 58 to col. 4 line 7).

Yasuda et al further discloses that the data can be data types of different telephone numbers, or other data types that are capable to be stored by the storage device RAM (9) (see col. 2, lines 66–68), and that the first apparatus (1B) is a programmable device (see col. 1, lines 33 and 34 and (8) of figure 1).

Yasuda fails expressly disclose the storage device (9) is for storing operating software and the updating means (8,11A, 11B, 21) for updating software, however, since the first apparatus (1B) inherently includes operating software, being stored in the storage device RAM(9), to be executed by microcomputer (8) to operate the system, therefore, the updating means

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inherently include updating the operating software for the first apparatus (1B) so that it is able to function with updated version.

Or, in the alternative, Ellis et al, in an analogous art, disclose that the storage device (RAM or ROM) is for storing operating software and able to be updated with an updating software being received from a remote station (see col. 9, lines 16–21). Therefore, it would have been obvious for a person skilled in the art to modify Yasuda et al in such a way that the data storing in the RAM or ROM is also storing the operating software and the updating means for updating the operating software, as taught by Ellis et al, in order to replace an outdated operating software with an updated software so that the first apparatus is able to function with updated version.

–Regarding to claim 6, Yasuda et al disclose that the method wherein taping update data from a second apparatus of the same type as the first apparatus to update data in the first apparatus includes:

Step (106,110) for preparation of a second apparatus (1A) for producing the update data (see Fig. 3, col. 4, lines 48–56),

Step (106,120) for preparation of a first apparatus (1B) for receiving the update (see Fig. 3, col. 4, line 48 to col. 5, line 10),

Step (120) for data transfer from the second apparatus to the first apparatus (see Fig. 3, col. 4, lines 48-60),

Step (121) for writing update data in the storage device of the first apparatus (see Fig. 3, col. 5, lines 31-38).

-Regarding to claim 7, Yasuda et al disclose updating means (8, 11A, 11B, 21) for exchanging data wherein the first apparatus (1A) comprises means for communicating its data and the second apparatus (1B) comprises means (storage device (9)) updated with update data from the first apparatus (see Fig. 3, col. 4, line 48 to col. 5, line 50).

Yasuda et al further discloses that the data can be data types of different telephone numbers, or other data types that are capable to be stored by the storage device RAM (9) (see col. 2, lines 66-68), and that the second apparatus (1B) is a programmable device (see col. 1, lines 33 and 34 and (8) of figure 1).

Yasuda fails expressly disclose the storage device (9) is for storing operating software and the updating means (8,11A, 11B, 21) for updating

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software, however, since the first apparatus (1B) is inherently includes operating software, being stored in the storage device RAM(9), to be executed by microcomputer (8) to operate the system, therefore, the updating means inherently include updating the operating software for the first apparatus (1B) so that it is able to function with updated version.

Or, in the alternative, Ellis et al, in an analogous art, disclose that the storage device (RAM or ROM) is for storing operating software and able to be updated with an updating software being received from a remote station (see col. 9, lines 16–21). Therefore, it would have been obvious for a person skilled in the art to modify Yasuda et al in such a way that the data storing in the RAM or ROM is also storing the operating software and the updating means for updating the operating software, as taught by Ellis et al, in order to replace an outdated operating software with an updated software so that the first apparatus is able to function with updated version.

7. Claim 3, 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yasuda et al in view of Kadaba et al (6,285,916) (prior art of record).

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-Regarding to claim 3 (see Yasuda et al Fig. 1 &2), Yasuda et al does not disclose said updating means are formed by an infrared link. But, Yasuda et al disclose said updating means are formed by a transfer link as a cable link (21) for transferring data from 1A to 1B (see Fig. 2).

Kadaba et al discloses that data can alternatively be transferred by cable link or Infrared link (see Kadaba et al Fig. 1, col. 5, line 12 to 21)

At the time of the invention was made, It would have been obvious for a person skilled in the art to alternatively implement Yasuda et al's transfer link as an infrared link in order to transfer data wirelessly.

-Regarding to claim 4 (see Yasuda et al Fig. 1 &2), Yasuda et al does not disclose said updating means are formed by a RF link. But, Yasuda et al disclose said updating means are formed by a transfer link as a cable link for transferring data from 1A to 1B (see Fig. 2).

Kadaba et al discloses that data can alternatively be transferred by cable link or RF link (see Kadaba et al Fig. 1, col. 5, line 12 to 21)

It would have been obvious for a person skilled in the art to alternatively implement Yasuda et al's invention to include RF link in order to transfer data wirelessly.

Response to Arguments

8. Applicant's arguments filed on 1/24/05 have been fully considered but they are not persuasive.

The applicant mainly argues that (i) the amendment for the Specification and the Abstract filed on 4/1/04 did not add new matter to the original disclosure because firstly, the original disclosure of the present application does have a need to rely on any teaching in PCT WO 97/35453, which supports the added new matter; therefore, there is no need to incorporate PCT WO 97/35453 by reference in the original specification, and secondly, the amendment is supported by the original disclosure on page 1, lines 1-12 and page 2, lines 18-30; and (ii) Neither Yasuda et al nor Ellis et al discloses the limitations "updating means for updating the operation software stored within said storage device via an interfacing with another apparatus of the same type", as recited in claim 1, "tapping update data from a second apparatus of the

same type as the first apparatus to update the operation software in the first apparatus”, as recited in claim 5, and “means for exchanging update data for updating operation software stored within a first apparatus, wherein a second apparatus communicates the update data to the first apparatus and the operation software stored within the first apparatus is updated with the update data”, as recited in claim 7.

–Regarding to part (i), the examiner respectfully disagrees. First of all, the original disclosure of the present application cannot rely on any teaching in PCT WO 97/35453 in order to avoid repeating some information contained in this patent document PCT WO 97/35453 by merely stating “Such an apparatus is known from patent document PCT WO 97/35453. For updating or modifying the operating software of the apparatus, there is proposed in this patent document to utilize a PC type of computer, for example” on page 1 of the specification because the original specification does not incorporate the patent document PCT WO 97/35453 by reference; the details of the patent document PCT WO 97/35453, therefore, is considered not part of the original specification (see MPEP 2163.07(b)). Also, the applicant is notified hereby that

the added new matter in the amendment for the Specification and the Abstract filed on 4/1/04 is considered "essential material" necessary to describe the claimed invention and provide an enabling disclosure of the claimed invention; and therefore, the added new matter may not even be incorporated by reference to the patent document PCT WO 97/35453 because the patent document PCT WO 97/35453 is not a U. S. Patent, U.S. patent application publication or a pending U.S. application (see MPEP 608.01(p) 1.A.). Secondly, the examiner does not find on page 1, lines 1-12 and page 2, lines 18-30 of the original disclosure any information which supports the added new matter's descriptions "the operation of the apparatus (1) depends on operation software contained in a storage device (45). It is often appears to be necessary to update the stored operation software. For this purpose, update data contained in another storage device of another apparatus (50), of the same type as the apparatus (1), is tapped by the apparatus (1) for storage within storage device (45). This updating technique for stored operation software has an application to portable cellular telephony apparatus", as stated in the abstract amendment and "the present invention proposes an apparatus that avoids the necessity of

using a computer for updating operation software within a storage device”, as stated in the specification amendment.

–Regarding to part (ii), the examiner also disagrees. Yasuda et al discloses updating means (8, 11A, 11B, 21) (see figures 1 and 2) for updating data stored within a storage device RAM (9) via an interfacing (11A, 11B, 21) with another apparatus of the same type, (regarding to claim 1), updating step (8, 11A, 11B, 21) of tapping update data from a second apparatus (1A) of the same type as the first apparatus (1B) to update the data in the first apparatus, (regarding to claim 5), and updating means (8, 11A, 11B, 21) for exchanging update data for updating data stored within a first apparatus (1B), wherein a second apparatus (1A) communicates the update data to the first apparatus and the data stored within the first apparatus is updated with the update data”, (regarding to claim 7). Yasuda et al further discloses that the data can be data types of different telephone numbers, or other data types that are capable to be stored by the storage device RAM (9) (see col. 2, lines 66–68), and that the first apparatus (1B) is a programmable device (see col. 1, lines 33 and 34 and (8) of

figure 1). Therefore, it inherently includes operation software, being stored in the storage device RAM (9), for the first apparatus to be executed.

Therefore, since in Yasuda et al invention, the storage device (9) is for storing operating software, the updating means (8, 11A, 11B, 21) is inherently or obviously capable of updating the operating software stored within said storage device from another apparatus (1A) of the same type in order to replace the operating software being stored within said storage device, when it becomes outdated, with a new updated version.

For clarifying the inherency or obviousness of a programmable device including operation software, which is stored in memory, and is capable to be updated from a remote station, the examiner also previously cited Ellis (6,771,317) who discloses a programmable device (figure 1) including operation software, which is stored in memory (18), and is capable to be updated from a remote station (see col. 8, line 65 to col. 9, line 32).

Based on the above rationale, it is believed that the limitations of claims are still met and therefore, the rejections are still maintained.

Conclusion

9. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanh D Phu whose telephone number is (703)305-8635. The examiner can normally be reached on 8:00-16:30.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sanh D. Phu
Examiner
Art Unit 2682

SP


VIVIAN CHIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

5/16/05